INDEX.

	Page
Petition	1
Registration Trade-Mark Label	3
Verification	11
Certificate of Counsel	12
Brief of Petitioner	12
General Statement of Case	12
Confusion of Circuit Court of Appeals	17
Rule as to Color	21
Conclusion	28
Cases Cited—	
Anheuser-Busch Co. vs. Clark, 26 Fed. 410	26
Coats vs. Merrick, 149 U. S. 562	20
Fairbanks vs. Bell, 77 Fed. 869	26
Fairbanks vs. Bell, quotation	27
Gulden vs. Chance, 182 Fed. 303	27
Heileman vs. Independent, 191 Fed. 489	26
Kostering vs. Seattle Brewing Co., 116 Fed. 620	26
Leschen vs. Broderick, 201 U. S. 166	23
McLean vs. Fleming, 96 U. S. 245	25
National Biscuit Co. vs. Swick, 121 Fed. 1007	27
New England Awl Co. vs. Marlborough, 168 Mass. 154	22-26
Newcomer vs. Scriven, 168 Fed. 621	23
Ohio Baking Co. vs. National, 127 Fed. 116	27
Schlitz vs. Houston, 241 Fed. 817	19
Stuart vs. Stewart, 91 Fed. 243	27

IN THE

Supreme Court of the United States.

OCTOBER TERM, A. D. 1917.

No. ——

JOSEPH SCHLITZ BREWING COMPANY, Complainant and Appellant,

vs.

HOUSTON ICE & BREWING COMPANY, H. HAMILTON, R. L. AUTREY, JAMES H. STUDDART, JESSE ANDREWS, JOSEPH F. MEYERS, B. A. RIESNER and D. ROSSI, as Trustees of the Houston Ice & Brewing Association, under a declaration of trust dated October 20th, 1914, and otherwise as successors and assigns of the said Houston Ice & Brewing Company, Defendants and Respondents.

Petition for a Writ of Certiorari requiring the United States Circuit Court of Appeals for the Fifth Circuit to certify to the Supreme Court of the United States for its review and determination of the case of Joseph Schlitz Brewing Company, Complainant and Appellant, vs. Houston Ice & Brewing Company, et al., Defendants and Respondents, No. 2990, submitted and argued in the October Term, 1916, on the 27th day of February, 1917, in said term and decided April 28th,

1917. Petition for Rehearing duly filed May 18th, 1917, and rehearing denied October 4th, 1917, and mandate returned to the District Court October 25th, 1917.

TO THE HONORABLE THE SUPREME COURT OF THE UNITED STATES:

The petition of Joseph Schlitz Brewing Company respectfully shows to this Honorable Court as follows:

First: That the petitioner is a corporation duly organized and existing under the laws of the State of Wisconsin, with its home office and principal place of business in the City of Milwaukee in the State of Wisconsin, and is engaged, among other things, in the sale of beer in bottles in commerce between the several states, including the States of Louisiana and Texas, and in foreign countries, including Mexico.

That the defendant, Houston Ice & Brewing Company, a Texas corporation, with its principal place of business in the City of Houston, in the State of Texas, was during the years 1902 to June, 1912, a wholesale agent for the petitioner and also engaged in the marketing and sale of beer in bottles in commerce between the States of Louisiana and Texas, and in foreign countries, including Mexico, in competition with petitioner. That the defendant, Houston Ice & Brewing Association, is a voluntary organization, successor to the Houston Ice & Brewing Company, and the personal defendants are its Trustees and Trustees under the Statutes of Texas of the dissolved corporation, Houston Ice & Brewing Company, and are all citizens and residents of the State of Texas.

Second: The petitioner, Joseph Schlitz Brewing Company, brought a suit in equity against the respondent, Houston Ice & Brewing Company, in the United States District Court for the Southern District of Texas, charging the respondent with infringement of its trade-mark label and unfair trade. The trade-mark label of petitioner originally adopted in 1894 is a parallelogram in solid body-color brown, pasted upon brown bottles containing petitioner's beer, and bears on the face thereof white, characteristic script and block lettering and the figure of a blue globe in distinctive arrangement. Such trade-mark label has been exclusively used by petitioner in commerce between the several states and in foreign countries, including the States of Louisiana and Texas and Mexico, where the defendant had done business for upwards of twenty years. This label is used in two sizes and is shown in color, letter-press and insignia thereon in the printed transcript submitted herewith, Exhibit "A" on page 17, the quart bottle size, and Exhibit "B," page 27, the pint bottle size. This trade-mark label was originally adopted because of its unique features. Application for registration was made in February, 1895, in the United States Patent Office and the label duly registered April 9th, 1895, trade-mark No. 26,385. Reference to the color of the background is made as follows:

> "The color and background of the trademark as used with the various brands of malt liquors varies, and aims to correspond with the color of the beverage so as to indicate at a glance the brand itself."

The rights under this registration were re-asserted in the Patent Office at Washington, D. C., by the petitioner as late as July 16th, 1912. (Trans. p. 56.) The

particular light-brown body-color upon the labels, Exhibit "A" and Exhibit "B," is the color used since the adoption of the label in 1894, upon all export beer in bottles put up and labeled by the petitioner at the brewery. Export beer is the brand customarily sold in commerce between the several states, including Louisiana and Texas and in foreign countries, and the small size label, Exhibit "B" on page 27 of the Transcript was the label used on the bottles contained in 817 car-load and half car-load shipments ordered by the respondent while agent of the petitioner, to be delivered to Texas and Louisiana points between the years 1902 and 1912. The specific charge of infringement and unfair trade is that the respondent after it ceased to be the agent of petitioner and in the summer of 1913 commenced to use upon beer of the respondent in brown bottles, a brown body-colored label in similitude to the label originally adopted and up to that time exclusively used by the petitioner to distinguish its product. (This label is shown in the Transcript of Record on page 17.) That by reason of the adoption of such imitative mark the public were led to believe that beer of the respondent so labeled was the beer of the petitioner.

Third: Respondent filed an Answer and among other things alleged that by reason of the differences in the wording upon the two labels used by it and the petitioner, there was sufficient differentiation. Respondent admitted the adoption of the brown body-colored label, but claimed the adoption by it of a brown label was merely to provide harmony between the color of the label and the color of the brown bottle which respondent had adopted for alleged scientific reasons. Respondent further admitted that the beer sold by the respondent,

while a jobber for the petitioner's product, was put up in pint bottles bearing the small size pint label, Exhibit "B," on page 27 of the Transcript. Respondent disclaimed any intention to defraud petitioner and voluntarily offered to change the label, and on the hearing of the motion for preliminary injunction soon after issue joined, submitted a new design, respondent's Exhibit "J," shown on page 31 of the Transcript, in which the characteristic "S" imitative of the petitioner's "S" upon respondent's first label was changed, and Judge W. T. Burns, United States District Court, denied petitioner's motion for a preliminary injunction.

Fourth: Thereafter in March, 1915, the cause came on for hearing before the Honorable W. T. Burns, District Judge for the Southern District of Texas, and at that time it developed that the respondent had again voluntarily changed the style of "S" in the script lettering upon the label. There was no controversy as to the important facts relied on by petitioner; that petitioner had first adopted the solid body-colored trade-mark label in 1894; that the label was registered in the United States Patent Office in 1895; that the petitioner had used the trade-mark label with brown background, white letter-press and blue figure thereon for more than twenty years, and had protested and stopped the use of labels having those characteristic features, as alleged infringements, in every instance that had come to the knowledge of the officers or agents of petitioner until the acts of the respondent complained of.

Petitioner also showed instances of passing and palming off of respondent's product marked with brown label, for product of petitioner, confusion caused thereby and

acts of unfair trade for which respondent disclaimed responsibility, but which the similitude of its package to that of petitioner's made possible.

Respondent admitted it had been a jobber of petitioner's product for ten years from 1902 to 1912, and that in the summer of 1913, it had first used the brown label upon beer in brown bottles, but denied any intention to defraud petitioner by the use of such brown label.

Respondent asserted on the argument that petitioner could have no monopoly of the color of such label and that the wording upon the respondent's label was distinct and different from the wording on petitioner's label. The District Court on April 11th, 1916, ordered the Bill of Complaint dismissed without findings of fact or opinion, and a final decree dismissing said bill was entered on that date.

Fifth: Thereupon your petitioner appealed to the United States Circuit Court of Appeals for the Fifth Judicial Circuit and assigned as error, the dismissal of petitioner's Bill of Complaint, among other things, because the issues and proofs at the trial had established the facts.

That the petitioner was the first and original appropriator of and had exclusively used the trade-mark label, Exhibits "A" and "B," in the color, arrangement of elements and letter-press thereon upon and in connection with the marketing and sale of beer in bottles for upwards of twenty years; that it had diligently asserted its exclusive right to use such label throughout the entire time after its adoption and had prevented by notice and appropriate court action every attempted infringement of the trade-mark label, Exhibit "A" and "B," and the color, letter-press and arrangement of

elements, in combination, which make up the trade-mark label of the petitioner.

Petitioner also claimed on appeal that the District Court erred in not finding that the respondent, having knowledge of the petitioner's exclusive right to the use of the brown label, was bound in equity and good conscience, when it entered the field previously exclusively occupied by the petitioner, that is, the marketing of beer in brown bottles with the brown label and the other elements thereon to so distinguish its label and dress of package that confusion would be impossible, and that imitation of the several important elements of petitioner's label under these circumstances entitled petitioner to the relief prayed for.

Petitioner further claimed that it was entitled to the relief prayed for upon the mere inspection of the labels, but upon the hearing of said cause offered evidence of passing and palming off of respondent's product marked with the imitative label complained of, as and for beer of the petitioner, and that agents of the respondent had tried to induce customers of petitioner to buy respondent's beer with brown label, to sell in place of petitioner's, though the officers of respondent denied either responsibility for or knowledge of such unfair dealing, and upon this evidence petitioner was entitled to the relief prayed for.

But the majority of the Circuit Court of Appeals in its opinion, filed on the 28th day of April, 1917, affirmed the decree of the District Court, reported in Volume 241 of the Federal Reporter at pages 817 to 824.

Sixth: Thereupon the petitioner, feeling itself unjustly and inequitably deprived of its trade-mark rights

by the dismemberment of its trade-mark by the majority of the Circuit Court of Appeals, and that the Court ought to have the opportunity to correct this error in the opinion and have the opportunity to apply the law and the former decisions of this Honorable Court and of the other Federal Courts to the facts disclosed by the record in this case, seasonably made a motion for a rehearing of the said case because of the manifest deprivation of the petitioner's rights, contrary to the established principles of the law of trade-marks.

Among other things petitioner directed the court's attention to the record where it was disclosed that the trade-mark of the petitioner as used in commerce between the several states and foreign countries, had been registered in 1894 and 1906 (Trans. pp. 176-199-175), that the color of background was indicative of the particular brand of beer, and that for twenty years before the trial the trade-mark label, in the color of background, style of letter-press and arrangement of elements thereon, shown in Exhibits "A" and "B," Trans. pp. 17 and 27, had been used by petitioner to the exclusion of the world, except for the alleged infringement by respondent in adopting the label, Exhibit "D," p. 17 of said Transcript. (Trans. pp. 176-58-60-62-74-75.)

Because the Circuit Court of Appeals refused to apply the principles of law as to the right of the owner of a trade-mark to claim as a trade-mark the color in combination with other distinctive elements, for example, the distinctive color of background, arrangement, style and color of letter-press and the blue figure, in distinctive combination, petitioner's distinctive arrangement of element, as used on a brown bottle for twenty years.

Because the Circuit Court of Appeals by *eliminating* the color of the label when it should have considered the color *in combination with other elements,* decided the rights of petitioner upon a device not used or claimed by petitioner as its mark, and not disclosed by the record. Counsel for the petitioner respectfully urged the court to consider the color as an essential element in the combination with other elements that go to make up the petitioner's trade-mark label, and award it the protection which the facts warranted, but the Circuit Court of Appeals on October 4th, 1917, denied petitioner's motion for a rehearing, and on the 25th day of October, 1917, mandate was issued to the District Court and the order of the District Court dismissing the Bill of Complaint made final.

Seventh: Petitioner respectfully submits that the reasons why it is entitled to a review of this cause are,

Because the Circuit Court of Appeals was without jurisdiction or authority to decide the case upon the dismembered mark referred to in the opinion, when the record established a trade-mark right in the petitioner to the trade-mark label, Exhibits "A" and "B," pp. 17 and 27 of the Transcript.

Because the majority of the Circuit Court of Appeals in its decision in this case refused to follow the principles of trade-mark law which guarantees protection to the first appropriator of a complex combination of elements as a trade-mark, of which an essential element may be the color.

Petitioner respectfully submits that the correction of the errors in the decision of the Circuit Court of Appeals is not only of great importance to the petitioner for the protection of its trade-mark rights, but is of

importance to all owners of trade-marks in which color is an essential element, *in connection with* other distinctive features, and which the elimination of color as was done in this case, would destroy.

Petitioner further respectfully submits that the Circuit Court of Appeals for the Fifth Circuit should obey and enforce the law as determined and announced in the decisions of this Honorable Court and other Federal Courts, to the end that owners of trade-marks, including petitioner, whose trade-marks have as an important element color, may be uniformly, justly and equitably dealt with, and the principles of trade-marks may be uniformly and equitably enforced throughout the Courts of the United States.

WHEREFORE, Your petitioner respectfully prays that a Writ of Certiorari may be issued out of and under the seal of this Honorable Court directed to the United States Circuit Court of Appeals for the Fifth Circuit commanding said Circuit Court of Appeals to certify and send to this court on a day certain, to be therein designated, the entire transcript of the record in the case of Joseph Schlitz Brewing Company, Complainant and Appellant, vs. Houston Ice & Brewing Company, et al., Defendants and Appellees, No. 2990, November Term, 1916, including the proceedings thereon in the Circuit Court of Appeals, to the end that the said case may be reviewed and determined by this court as provided by law, or that your petitioner may have such other or further relief or remedy in the premises as to this court may seem proper and in conformity with law, and that said decree of the Circuit Court of Appeals in the said case and every part thereof may be reversed by this Honorable Court.

And your petitioner will every pray, etc.,

JOSEPH SCHLITZ BREWING COMPANY,
RUSSELL JACKSON,
Counsel for Petitioner.

RUSSELL JACKSON,
Counsel for Petitioner.

STATE OF WISCONSIN, } ss.
MILWAUKEE COUNTY. }

J. W. McMillan, being duly sworn, deposes and says that he was counsel for the petitioner, Joseph Schlitz Brewing Company, and had personal charge for it of the case in the United States Circuit Court of Appeals for the Fifth Judicial Circuit referred to in the foregoing petition and that he had personal charge of the case in the District Court; that he has read the foregoing petition and knows the contents thereof and that the facts therein stated are true of his own knowledge; that he makes this verification for the petitioner for the reason that the said petitioner is a corporation and that the only facts involved in the said petition relate to the records, files and proceedings in said case which are all within the knowledge of the affiant.

Affiant further says that in his opinion the foregoing petition is well taken in point of law and ought to be granted.

J. W. McMILLAN.

Subscribed to and sworn to before me, this 27th day of December, 1917.

ARNOLD C. OTTO,
Notary Public, Milwaukee County, Wis.

CERTIFICATE OF COUNSEL.

I hereby certify that in my opinion the foregoing petition is well taken in point of law and ought to be granted.

RUSSELL JACKSON,
Counsel for Petitioner.

BRIEF ON BEHALF OF THE PETITIONER.

Petitioner files this application for a Writ of Certiorari because a majority of the Circuit Court of Appeals for the Fifth Circuit failed to conceive the trade-mark label of the petitioner as disclosed by the record in the case, and determined the rights of petitioner upon disassociated parts of the label never used by petitioner to distinguish its goods;

Because the majority of the Circuit Court of Appeals failed to follow the law applicable to trade-marks in which color, in definite association with other elements and characteristics, is the basis of trade-mark rights, and

Because such failure on the part of a majority of said court to conceive the facts and obey and enforce the law, in such cases has not only resulted in great injustice and inequity to the petitioner, but will result in great injustice and inequity to the owners of trade-marks in which color is a most important element.

GENERAL STATEMENT OF THE CASE.

This is a suit in equity and the Bill of Complaint charges the respondent with the infringement of the

registered trade-mark label of petitioner, originally registered in the office of the United States Commissioner of Patents in April, 1895, trade-mark No. 26,385, re-registered under the Act of Congress February 20th, 1905, on the 1st day of May, 1906, trade-mark No. 52,011 (Trans. p. 17, Exhibit "A," Trans. p. 27, Exhibit "B"), and of the infringement of the label adopted by petitioner in 1894 and since that time used by the petitioner in distinctive colors and arrangement of elements, to the exclusion of the world, except for the acts of the respondent, and also charges the respondent with unfair trade by the adoption and use of a label in color of background, style of lettering and color and arrangement of elements in such similitude to the color of background, style of letter-press and color and arrangement of elements upon the label of the petitioner; that goods of respondent were and would be passed and palmed off as and for goods of the petitioner to its great injury and damage.

The label of the petitioner adopted in 1894 and since used by it, is a parallelogram of light brown background, the name "Schlitz" appears in white, characteristic ornamental script, slanting upwards from left to right across the label, and underneath the white script lettering in white block lettering are the words, "The Beer That Made Milwaukee Famous." On the left hand side of the label is distinctly shown the picture of a globe in blue. Around the label near the outer edges is a white marginal line. The label is used in two sizes, the small size which is attached to twelve ounce or pint bottles, and a large size is attached to twenty-four ounce or quart bottles. The design, letter-press, color and arrangement of elements is alike upon both sizes.

The label of the respondent adopted in August, 1913,

is oblong in shape, approximately the size of the parallelogram used by petitioner for the large size label. The color of background is strikingly similar to the color of background previous to that time used only by petitioner, a light brown body color, and the label has a white marginal line around it near the outer edge, also upon petitioner's label. The name of respondent's product is written in ornamental script, slanting upwards from left to right across the label. The first letter of the name upon both the labels of the respondent and the petitioner is "S." This letter, distinctive upon petitioner's label, with its characteristic flourishes and shading, is copied upon respondent's infringing label. (Trans. pp. 17 and 27.) The name upon respondent's first label is finished with a distinctive paraph or shading almost identical with the paraph upon the petitioner's label. Both names, though different, are written in ornamental script, peculiar to the petitioner's label, slanting upwards from left to right, and the color of background and the color and slant of the lettering and the color and location of the circular figure are similar upon both labels.

Previous to the acts of respondent in adopting the brown body-colored label, the petitioner was the exclusive user, in the States of Louisiana and Texas and in Mexico, where the respondent was a competitor, as well as everywhere else in the world where petitioner's product was and is sold, of the brown body-colored label with white characteristic ornamental script lettering across the center, slanting upwards from left to right, white block lettering underneath and a blue circular figure on the left side of such label. Petitioner had continuously enjoyed the exclusive use of this brown body-

colored label in combination with the other elements described upon and in connection with the marketing of beer in brown bottles, in commerce between the states and with foreign countries, except for the interruptions by alleged infringers mentioned by petitioner's witnesses at the hearing of the suit, all of whom had been notified to refrain, and had refrained, from the use of such imitative label or were compelled to desist from such alleged infringement by appropriate court action, leaving petitioner in exclusive enjoyment of its brown trade-mark label at the time of the infringement by the respondent herein complained of.

On the hearing petitioner alleged and proved specific instances of confusion that had resulted from the adoption by the respondent of the brown body-colored label, and that beer of the respondent had been passed and palmed off as and for beer of the petitioner; that unscrupulous dealers had been induced by the similarity between the two labels to pass and palm off the product of the respondent for the product of petitioner; that experienced retailers of beer had confused the two labels because of their similarity, and because by long-continued use they associated the brown bottle and brown label with petitioner's product. Petitioner also alleged and proved that agents of respondent had endeavored to induce unscrupulous dealers to purchase beer of the respondent to re-sell as and for beer of the petitioner, by reason of the similarity of the dress of the beer of the respondent, but the officers of respondent disclaimed either authority or responsibility for such acts of unfair trade.

Respondent answered that the labels of petitioner and respondent were distinguishable in the wording

thereon, and the difference in size between the small label of petitioner and label of respondent which was used upon both twelve ounce or pint bottles, and twenty-four ounce or quart size bottles. The respondent disclaimed intention to defraud petitioner, but voluntarily changed the characteristic "S" (which was almost an exact copy of the "S" upon petitioner's label), upon the first label adopted by respondents to an "S" of different design, shown on Exhibit "J," on page 31 of the Transcript, and changed the design of the paraph or shading underneath the lettering to a flourish somewhat less a copy of the paraph upon the petitioner's label.

Before the cause came for trial it appears the respondent again voluntarily changed the label a third time and at the time of the trial was using a design shown on page 209 of the printed Transcript.

The petitioner attached to ninety per cent of the beer bottled by it, the distinctive labels, Exhibits "A" and "B," pages 17 and 27 of the Transcript.

Respondent admitted that petitioner had extensive trade in Texas, the market supplied by the respondent. During the six years preceding the filing of the complaint petitioner had sold in the State of Texas fifty million bottles of beer labeled with its light brown body-colored label.

Between 1902 and 1912 the respondent had been a jobber of the petitioner's beer at the same time manufacturing its Southern Select beer which was put up in clear glass bottles and sold with a white label, Exhibit "D" on page 208 of the Transcript. Respondent was responsible for the sale of 817 car-load and half car-load shipments of beer in bottles from the petitioner's brewery to points in Louisiana and Texas, all of which

bottles were labeled with petitioner's light brown body-colored label.

The petitioner markets its product throughout the world. Ninety per cent of its beer put up in bottles is marketed in brown bottles labeled with the brown body-colored label, upon which are the other characteristics in color. It has registered its label in every country in the world to which its product is sent. At the time of the filing of this complaint it sold its product in the Republic of Mexico, a market where respondent also had some trade and was in competition with petitioner. It sold and now sells its product in Cuba, a market tributary to Houston, Texas, where it comes into direct competition with respondent, and moreover the respondent had been a jobber of its product and knew its distinctive mark for many years.

CONFUSION OF CIRCUIT COURT OF APPEALS.

The Circuit Court of Appeals failed to conceive the trade-mark which was the subject of the suit and the badge of identification of the petitioner's product will be evident upon a brief resume of the case disclosed by the Transcript.

In the Bill of Complaint petitioner described in detail the trade-mark label which was the badge of identification of its product, and made particular reference to the color of the respective elements described as well as their arrangement. (Trans. pp. 4 and 5.)

The label in colors was attached to the Bill of Complaint, Exhibit "A," Trans. p. 17, being the large size label, and the small sized label on a pint bottle was filed with the complaint, Exhibit "D."

It was not controverted that petitioner was the first to use a solid body-color other than white upon a beer label, and that petitioner had used the brown body-colored label upon its brand of beer most commonly sold in commerce between the states and with foreign countries since 1894. (Trans. p. 57.)

On pp. 59, et seq., of the Transcript testimony is given by the manager of the bottling department of petitioner of a number of instances where the question as to petitioner's right to use the brown label was in issue, and Mr. Bielfeld testifies that in every instance where such alleged infringements came to the knowledge of the petitioner, steps were taken to stop the use by a competitor of a brown label upon beer in brown bottles in similitude to petitioner's trade-mark label.

Petitioner's witnesses testified to numerous instances in which the advertising of petitioner bore a fac-simile *in colors* of petitioner's label. (Trans. p. 66.)

Of the three hundred and fifty million bottles of beer disposed of by the petitioner in the six years prior to the filing of the suit, eighty per cent were put up in brown bottles and labeled with petitioner's brown label, the subject of this suit. Of the fifty million bottles disposed of in the State of Texas in those same six years practically all were of this brand, and bore the brown label.

There is not one syllable of testimony in the entire record that any other distributor or manufacturer of beer used a brown label of any kind, and it is fair to assume counsel for respondent would have found evidence of the use of other brown labels if such proof was available. The secretary of respondent company testified that about twelve days before the trial he wrote to every brewery in the United States as published in Toby's

Directory, to send him their labels, and he finds in such labels elements of petitioner's label reproduced, but does not claim the brown body-color as one of the elements found. (Trans. p. 173.)

The court in its opinion reported in 241 Fed. 817, at p. 819, finds:

> "The plaintiff had for twenty years or more distributed its bottled beer in brown bottles with a brown label." * * *
>
> "The alleged infringement and unfair competition was based on the use by the defendant of a label on its bottles, claimed to have resembled plaintiff's label so closely as to mislead purchasers into the belief that they were buying plaintiff's product, when they were in fact buying that of the defendants."

The court continued:

> "The dress of defendant's bottled beer which gives rise to the complaint of the plaintiff, consisted in its having been put up in brown bottles with a brown label, charged to have been imitative of that of the plaintiff." (P. 820.)

In another place in the opinion the court says:

> "Its (petitioner's) exact contention is that the dress of its bottled product in brown bottles with brown labels, *in combination with certain other elements* in the label peculiar to it, is entitled to protection, and that the defendants by their use of a brown bottle with a brown label with certain imitative characteristics, has violated its rights." (P. 820.)

Again on page 821.

> "A brown bottle with a brown label indicates to many the beer of the plaintiff. If they examined no further than the color of the bottle and the color of the label, the deception as to the origin of the beer would be complete." * * *

So far the court has stuck to the record and the issues in the case, but when the court says:

> "The plaintiff does not contend that * * * it has acquired the exclusive right to use either brown labels in bottling its beer" (P. 820),

or that,

> "Plaintiff's counsel concedes that neither the brown bottle, nor the brown label, nor both in combination apart from other points of resemblance, would establish infringement or unfair competition,"

it indulges in *obiter dicta*, for no question was presented in this case as to petitioner's right to the brown label aside from other points of resemblance, for the respondent had imitated not only the color of background, but had imitated the style of lettering, the arrangement of elements and the coloring of each upon a label slightly different in size and shape, and with different wording thereon. The color of background, the slant of the lettering and its position upon the label, the style of lettering and its color, and the color and position of the blue figure were all imitated.

There is not a syllable of testimony in the record to support the assertion that all breweries had the right to use the brown bottle with brown labels. (Opinion, p. 821.) Nothing in the record discloses a case like

> *Coats vs. Merrick Thread Co.*, 149 U. S. 562-573,

quoted from in the opinion. In that case the record disclosed that thread manufacturers had used black and gold labels for fifty years. In this case the record discloses no instance of any other brewer using brown

labels upon brown bottles, except such as were stopped by petitioner.

If, as the court says, the brown label indicates to many the beer of the petitioner and no other brewer has used a brown label for the twenty years that petitioner has used that mark, then it had acquired a secondary meaning which the respondent was bound to respect and the court should have granted the petitioner the relief prayed for.

RULE AS TO COLOR.

Petitioner's counsel on the hearing of this case in the District Court and upon the argument in the Circuit Court of Appeals endeavored to enlighten the courts as to the exact position of the petitioner regarding the color of its label.

The theory of the petitioner's entire case from the commencement of the suit has been that by reason of the exclusive use of the particular trade-mark label with a brown body-color upon brown bottles containing beer, for upwards of twenty years, the petitioner is entitled to the protection of the color of said label in combination or association with the other characteristics that go to make up the badge of identification of petitioner's product.

Counsel for the respondent charged that petitioner was asking for a monopoly of the color brown, to which petitioner's counsel answered that petitioner made no such claim to the color brown in and of itself, but did claim, and the record disclosed that the petitioner claimed, the brown colored label *in combination with the other elements which go to make up its trade-mark label.*

The rule for which counsel has uniformly contended is better stated than counsel can state it by Mr. Justice Holmes in the case of

New England N. E. Awl Co. vs. Marlborough, 168 Mass. 154, cited by the Circuit Court of Appeals on page 821 of its reported opinion,

> "Of course a person cannot claim the monopoly of a color in connection with a particular line of trade, and very likely not in connection with the labels of a certain kind of goods generally. *But the most universal element may be appropriated as a specific mark of a plaintiff's goods, if it is used and claimed only in connection with a sufficiently complex combination of other things.* The plaintiff did not claim the exclusive right to brown labels for awls, but it claimed the exclusive *use of the brown color in combination,* which we have described."

The case under consideration is just that. The petitioner claims the brown label in combination with the other elements heretofore described, and particularly set forth in the complaint and uniformly alluded to in the testimony.

When the Circuit Court of Appeals eliminates the brown color from the label it bases its decision upon elements, which, aside from the color, have never been used by the petitioner to identify its goods.

As counsel for the petitioner understood the rule regarding color, it would have been unavailing for petitioner to have claimed an exclusive right to a particular color except the color "be impressed in a particular design as a circle, square, triangle, a cross or a star," citing:

Leschen Rope Co. vs. Broderick, 201 U. S. 166, p. 171, or as Mr. Justice Lurton says in

Newcomer vs. Scriven, 168 Fed. at p. 623.

> "Color, except in connection with some definite, arbitrary design such as when impressed upon a circle, star, cross or other figure, or employed in definite association with some characteristics which serve to distinguish the article as made or sold by a particular person, is not the subject of monopoly as a trade-mark."

We endeavored to point out to both the District Court and the Circuit Court of Appeals that respondent had imitated not only the color of background, but the style of lettering, the arrangement of the elements and the color of each as they had appeared upon the petitioner's label *in combination.*

Petitioner submits that the disclaimer of a monopoly of the color brown in and of itself is consistent with the further claim that this element to which it may not have the exclusive right in and of itself may still be the most important element in petitioner's label combination, and when the Circuit Court of Appeals eliminates that most important element from the combination claimed by the petitioner, it has decided the case upon a combination not claimed by the petitioner, never used by it, and not disclosed in the record except in combination with the particular color which is its most essential feature.

If a patent combination or a combination of elements in a trade-mark can be dissected so as to eliminate a most important element in the combination, then long-established rights based upon such combination, however exclusive, are insecure.

We are constrained to believe that the Circuit Court of Appeals failed to appreciate that trade-mark rights may be asserted to a combination of elements, notwithstanding a most important element thereof may not be the subject of exclusive appropriation, and this is quite evident from the citations and quotations from cases relied upon by the Circuit Court of Appeals to support its conclusion, whereas the cases cited expressly support the position of the petitioner as to its established rights to use upon a brown bottle containing beer a brown label in combination with the other elements which go to make up petitioner's distinctive mark.

The Circuit Court of Appeals' decision is in direct conflict with every important adjudication upon trade-mark rights arising from the use of a trade-mark having a number of elements, of which color is one of the principal elements.

Upon the argument before the Circuit Court of Appeals a large part of the brief was devoted to a discussion of the law as to color. In the course of the argument counsel for the petitioner asserted that after twenty years exclusive user, the petitioner's product was known as "the brown label beer."

No other manufacturer of beer in bottles had ever used a brown label in similitude to petitioner's label upon beer in brown bottles with the acquiescence or consent of the petitioner or its officers.

In at least one instance, Exhibit "G," the only points of similarity were the brown label with white lettering, Peterson's standard beer in similitude of the petitioner's label, and the use of the label objected to had been discontinued. Petitioner did not rely solely upon the shape

or size of its label, but particularly objected to infringements by the simulation of the color of background, color and style of letter-press and color of figure on the left hand side, that is, any combination which in general appearance suggested the exclusive brown label of the petitioner with its white letter-press and blue figure thereon.

If the Circuit Court of Appeals had followed the decisions in this situation and adjudicated the trade-mark of the petitioner, adopted in 1894 and continuously thereafter used in commerce between the several states and in foreign countries, it could have come to but one conclusion, that the petitioner was entitled to protection of its trade-mark, the color of which was its most essential element.

In support of this conclusion we respectfully direct the court's attention to the following cases:

This Honorable Court, speaking through Mr. Justice Clifford, says in

McLean vs. Fleming, 96 U. S. 245, p. 255.

> "Mention may also be made of the fact that the color of the label and the wax impression on top of the box are well suited to divert the attention of the unsuspecting buyer from any critical examination of the prepared article."

At p. 256 the court says:

> "Difference between those exhibits and Exhibits 'F' and 'H' of the complainant undoubtedly exist; and still it is manifest that the general appearance of the package in the respects mentioned, and others which might be suggested, is well calculated to mislead and deceive the unwary and all others who purchase the article without opening the box and examining the label."

We direct the court's attention to the language of Mr. Justice Holmes in New England Awl Company case, quoted in the report of this case, 241 Fed. Rep. at page 821, and previously here referred to.

In *Anheuser-Busch Brewing Association vs. Clark*, 26 Fed. 410, complainant was the first to use for bottled beer a label with a diagonal red band extending *downward* from left to right, with the name of the kind of beer appearing in white letters upon such band and the defendant used a label which consisted in part of a diagonal red band extending *upward* from left to right with the kind of beer also appearing in white letters upon the band, an injunction was granted though the labels were otherwise strikingly dissimilar.

In *G. Heileman Brewing Co. vs. Independent Brewing Co.*, 191 Fed. 489, the imitation of a conventional design in general color and arrangement of elements was enjoined.

And in *Kostering vs. Seattle Brewing Co.*, 116 Fed. 620, the court awarded an injunction upon the general appearance and dress of the package and the court says:

> "Many consumers of beer are unable to read and many are foreigners and unacquainted with the English language. All consumers, whether able to read or not, are guided by the general appearance of the package or label which is before them."

Other cases upon which the petitioner relied, and to which it cited the Circuit Court of Appeals, are,

The case of *Fairbanks vs. Bell*, 77 Fed. 869, 23 C. C. A. 554. The picture of the package appears on page 559 of the C. C. A. reports. The court held that notwithstanding distinctive features where the yellow color

of the complainant's package was copied by the defendant, there was a manifest intent to simulate complainant's packages and an injunction should issue. The court in that case has this to say about color:

> "Color, undoubtedly, is a most important element in all package combinations; but there are other elements as well which go to make up the entire combination. * * * It would not be giving the complainant a monopoly of yellow to restrain the sale of a particular yellow package, where, in addition to the color, a number of other elements each differing more or less from its analogue in complainant's package had been so collocated together as to produce a general appearance calculated to delude the unwary purchaser." 77 Fed. p. 876.

This is precisely what the respondent did in the present case and this was the contention of the petitioner's counsel on the argument of this case, and the theory upon which the case was tried from the commencement of the suit.

Stuart vs. Stewart, 91 Fed. 243; 33 C. C. A. 481.

In that case the rectangular, oblong box in which pills were sold was of a light blue color and the court enjoined the defendant from using his name which was *idem sonams,* on a box of *indigo* blue color.

In *Ohio Baking Co. vs. National Biscuit Co.,* 127 Fed. p. 116, and in *National Biscuit Co. vs. Swick,* 121 Fed. 1007, the trade-marks, shown in reports, were quite dissimilar, but printed upon bright red background, and the use of the mark was enjoined, on account of the color.

In *Gulden vs. Chance,* 182 Fed. 303, the labels printed in colors opposite page 303 in the report, the colors and shape of labels are similar, but the details of printed

matter upon them are different, but the court awarded complainant relief, and so in the case of *Wrigley vs. Grove Company,* 183 Fed. 99, the court awarded complainant relief where the color scheme of plaintiff's gum box was imitated, although the details of the labels were quite different.

CONCLUSION.

We deem it unnecessary to continue the citation of authority to this Honorable Court. We are unable to find any authority upon which the majority of the Circuit Court of Appeals can justify the dismemberment of petitioner's trade-mark.

We respectfully submit that petitioner made no claim in this suit except upon the trade-mark as used in distinctive color and arrangement of elements in combination.

That the Circuit Court of Appeals failed to follow the adjudicated cases as to the protection of trade-marks in colors.

We respectfully submit that petitioner is entitled to a Writ of Certiorari compelling the Circuit Court of Appeals for the Fifth Circuit to transmit to this Honorable Court the record in this case to the end that the petitioner may be afforded the relief upon the subject matter disclosed by the record in the case, and not upon a device which petitioner never claimed nor used.

Petitioner respectfully submits that it was the duty of the Circuit Court of Appeals upon the undisputed allegations in the petitioner's Bill of Complaint and the uncontroverted facts adduced upon the hearing of the case, to award the petitioner the relief prayed for under

the uniform decisions of this Honorable Court, and of the leading Circuit Courts of Appeals conversant with the adjudication of trademark rights.

The petitioner does not ask this Honorable Court to review an exercise of judicial discretion nor a finding upon conflicting evidence, but submits that the subject matter of the suit, the theory of the petitioner's case from the commencement of this suit, the undisputed facts disclosed in the record establish a consistent claim by petitioner to its brown label and other elements in the colors heretofore described, used upon beer in brown bottles, and the Circuit Court of Appeals was in duty bound to award the petitioner the relief prayed for under the law and decisions.

The respondent, having knowledge of the petitioner's exclusive rights while acting as a jobber of petitioner's product and in general as a competitor in the same field for nearly twenty years, owed a duty to petitioner when it put up its beer in brown bottles to so distinguish its product by a distinguishing label that confusion would not result, and petitioner should have an injunction enjoining respondent from using upon and in connection with the sale of beer in brown bottles, a brown label in similitude to the petitioner's brown label.

Respectfully submitted,

RUSSELL JACKSON,
Counsel for the Petitioner.